

REMARKS

Following entry of this Amendment, claims 1-40 are pending in the application. Applicants have amended claim 1 to recite “suspending the host cells...” and “freezing and thawing the host cells either before or after the suspending....” That amendment is supported by the specification, for example, at page 5, line 22, through page 6, line 3. Claim 1 has also been amended to delete the terms “the steps of” and “competent.” Those amendments do not narrow the scope of the claim and do not add new matter. In the last line of claim 1, the word “bacterial” was replaced with the word “host,” which corresponds with the preamble.

Applicants have amended claim 21 to recite “a cryopreservative selected from glycerol and dimethyl sulfoxide.” That amendment is supported by the specification, for example, at page 11, lines 7-8. Applicants have added new claim 39, which recites “wherein the non-ionic solution comprises glycerol at a concentration of 10% to 15%,” and new claim 40, which recites “wherein the cryopreservative comprises glycerol at a concentration of 10% to 15%.” New claims 39 and 40 are supported by the specification, for example, at page 11, lines 3-4 and lines 7-8; and at page 13, lines 11-12.

Applicants have amended claims 20 and 38 to recite “a mixture of sugars, sugar derivatives, or both sugars and sugar derivatives.” That amendment is supported by the specification, for example, at page 8, lines 3-6.

Applicants have amended claim 5 to add the word “claim,” which introduces no new matter. Applicants have also amended claims 7 and 25 to add the “%” symbol after the number “2.0,” which introduces no new matter. Applicants have amended claims 6,

18, 23, 24, and 36 to clarify the antecedent basis for certain claim terms. Applicants have amended claims 9, 11, 13, 15, 17, 27, 29, 31, 33, and 35 to delete the phrase “the group consisting of.” The amendments described in this paragraph do not narrow the scope of the claims. None of the foregoing amendments add new matter.

I. Claim Rejections Under 35 U.S.C. §101 (Statutory Double Patenting Rejections)

The Examiner rejected claims 3 and 4 under 35 U.S.C. §101 as allegedly claiming the same invention as that of claims 1 and 4, respectively, of U.S. Patent No. 6,338,965 (the '965 patent). Office Action at page 2. Without acquiescing to that rejection and solely to expedite prosecution, Applicants have amended claim 1 of the present application to recite “suspending the host cells...” and “freezing and thawing the host cells either before or after the suspending....” Claims 3 and 4, which depend from claim 1, thus encompass those elements. Claims 1 and 4 of the '965 patent do not recite those elements. Thus, claims 3 and 4 of the present application are not identical to claims 1 and 4 of the '965 patent.

The Examiner also rejected claims 1, 2, and 5-38 as allegedly claiming the same invention as that of claims 1-19, 22-35, 20, 21, and 36, respectively, of U.S. Patent No. 6,586,249 (the '249 patent). Office Action at page 2. Thus, the rejection of claims 1, 2, and 5-20 of the present application is based on claims 1-18 of the '249 patent. As discussed above, Applicants have amended claim 1 of the present application to recite “suspending the host cells...” and “freezing and thawing the host cells either before or after the suspending....” Claims 2 and 5-20 of the present application ultimately depend from claim 1 and thus encompass those elements. None of claims 1-18 of the '249 patent recite “suspending the host cells...” and “freezing and thawing the host cells

either before or after the suspending....” Thus, claims 1, 2, and 5-20 of the present application are not identical to claims 1-18 of the '249 patent.

Furthermore, the rejection of claims 21-38 of the present application is based on claims 19, 22-35, 20, 21, and 36, respectively, of the '249 patent. Applicants have amended claim 21 of the present application to recite “a cryopreservative selected from glycerol and dimethyl sulfoxide.” Claims 22-38 of the present application ultimately depend from claim 21 and thus encompass that element. None of claims 19, 22-35, 20, 21, and 36 of the '249 patent recite “a cryopreservative selected from glycerol and dimethyl sulfoxide.” Thus, claims 21-38 of the present application are not identical to claims 19, 22-35, 20, 21, and 36 of the '249 patent.

Applicants thus request withdrawal of the rejections of claims 1-38 under 35 U.S.C. § 101.

II. Obviousness-Type Double Patenting Rejections

The Examiner rejected claims 1-38 under the judicially created doctrine of obviousness-type double patenting in view of certain claims of U.S. Patent Nos. 6,338,965, 6,040,184, and 6,586,249. Office Action at pages 3-5. Solely to expedite prosecution and without acquiescing to that rejection, Applicants file herewith a terminal disclaimer to obviate that rejection.

Applicants need not address the propriety of the Examiner's allegations concerning this rejection in view of the Terminal Disclaimer. Applicants, however, do not acquiesce to any of those allegations. For example, the Examiner's use of the specifications of the cited patents to show claim elements in the present application is improper. Patent specifications may be used to construe **claims of the cited patent** in

such a rejection, but may not be used to show claim elements of the rejected application.

CONCLUSION

Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 14, 2004

By: *Danielle Pasqualone*
Danielle M. Pasqualone
Reg. No. 43,847
Customer No. 22,852